REMARKS

Claims 1-32 are pending. Claims 1 and 17 are amended. No new matter is added. The Examiner rejected claims 1-32 under 35 U.S.C. § 103(a) as being unpatentable over Microsoft® Outlook® 2000 (1999, hereinafter "Outlook") and further in view of the Applicant's Admitted Prior Art (Specification, filed Feb 6, 2002, hereinafter "AAPA"). The applicant respectfully traverses the rejections and requests reconsideration in view of the amendments and remarks herein.

Claims 17-32

The applicant respectfully submits the Examiner has failed to show a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations" [MPEP, §2143]. Even in combination, the two references fail to disclose all the limitations recited in claim 17. Claim 17, as amended, reads as follows:

> A computer program product, tangibly stored on a machine-readable medium, comprising instructions operable to cause a programmable processor to:
> establish an electronic signature appearance for an electronic signature for an electronic document to be signed, where:
> the electronic signature appearance comprises a visual manifestation of a signer's signature on the electronic document and includes a plurality of layers including a first validity layer for presentation of a dynamic validity graphic, an appearance layer for presentation of the visual manifestation of the signer's signature, and a second validity layer above the first validity layer for presentation of an invalidity graphic; and
> the electronic signature comprises code derived from a signed electronic document and a private key;
> determine a bounding region on the electronic document for the display of the electronic signature appearance;
> at the time a user is electronically signing the electronic document, display a preview of the electronic signature appearance in the bounding region, where the electronic signature appearance can be edited based on a user input after displaying a preview of the electronic signature appearance and before interaction with a user to electronically sign the electronic document; and
> interact with a user to sign the electronic document with the electronic signature, the electronic signature appearance being included in the electronic document signed with the electronic signature;

wherein, prior to validation of the electronic signature, a default validity graphic is presented in the first validity layer and if the electronic signature is validated then the electronic signature appearance dynamically changes to present a validity graphic in the first validity layer reflecting the validation and if the electronic signature is invalidated, then the electronic signature appearance dynamically changes to present an invalidity graphic in the second validity layer reflecting the invalidation.

The Examiner asserts that Outlook discloses signing an electronic document, including all of the limitations of claim 17, other than "the electronic signature comprising code derived from a signed electronic document and a private key". With respect to the above limitation, which is a clarification of the term "electronic signature" as defined and used within the specification, the Examiner relies on the AAPA, wherein the applicant describes a conventional public-private key implementation of an electronic signature (Specification, p. 1, ll. 9-17). The Examiner asserts it would have been obvious to have combined the AAPA with Outlook.

The applicant respectfully submits that even if the AAPA is combined with Outlook, the combined references do not teach or suggest all of the claim limitations. In reading the claim, the difference between the <u>appearance</u> and the actual <u>digital signature</u> (termed "electronic signature" in the claim) must be kept in mind. The electronic signature "comprises code derived from a signed electronic document and a private key", whereas the electronic signature appearance includes "a visual manifestation of a signer's signature".

Further, claim 17 has been amended to recite that the electronic signature appearance includes multiple layers. The layers include a first validity layer for presentation of a dynamic validity graphic, an appearance layer for presentation of the visual manifestation of the signer's signature, and a second validity layer above the first validity layer for presentation of an invalidity graphic. Prior to validation of the electronic signature, a default validity graphic is presented in the first validity layer. If the electronic signature is validated, then the electronic signature appearance dynamically changes to present a validity graphic in the first validity layer reflecting the validation. If the electronic signature is invalidated, then the electronic signature appearance dynamically changes to present an invalidity graphic in the second validity layer reflecting the invalidation.

Outlook does not disclose an electronic signature appearance meeting the definition recited in claim 17. That is, Outlook does not disclose an electronic signature appearance including layers, where two of the layers can be used to display validity or invalidity graphics. Figures 1-5 of the Outlook reference relied on by the Examiner simply show text and/or graphics that can be included within an email. There is no disclosure that the text provides any information that relates to the validity or invalidity of an electronic signature applied to the email.

The applicant respectfully submits the Examiner has misunderstood the important difference between an electronic signature and an electronic signature appearance. The signature feature shown in Figures 1-5 provided by the Examiner illustrate a signature *appearance* feature provided by Outlook. That is, the Outlook signature includes text and/or graphical images and provide an appearance of a signature; however, the claim calls for an appearance of an <u>electronic signature</u>. Further, using the signature feature shown in Figures 1-5, the Outlook email message is not "electronically signed" nor is an "electronic signature" created, as those terms are known in the art and used and defined within the specification in some detail. As discussed above, the difference between an <u>electronic signature appearance</u> and an <u>electronic signature</u> must be kept in mind, as these terms are fundamental to understanding the computer program product recited in claim 17. The Outlook signature feature shown in Figures 1-5 simply does not provide for an electronic signature; there is no electronic signing of a document, which requires deriving code from the electronic document and a private key.

An advantage of the electronic signature appearance recited in claim 17 is the dynamic aspect of the validity and invalidity graphics. That is, prior to validation of the electronic signature, a default validity graphic is presented in the first validity layer (by way of illustrative example, and without limitation, the default validity graphic may be a question mark). If the electronic signature is validated, then the electronic signature appearance dynamically changes to present a validity graphic in the first validity layer reflecting the validation. If the electronic signature is invalidated, then the electronic signature appearance dynamically changes to present an invalidity graphic in the second validity layer reflecting the invalidation. The dynamic changing of the validity or invalidity graphic provides instant visual information to a viewer of

the electronic document as to the validity of the electronic signature. This information is provided as part of the electronic signature appearance.

The AAPA does not cure the deficiency of the Outlook reference. The AAPA describes a conventional electronic signature implementation. However, there is no disclosure of previewing of an electronic signature appearance in a bounding region, and no ability to then edit the electronic signature appearance after previewing but before electronically signing the document. Further, there is no disclosure of an electronic signature appearance including multiple layers, such that the electronic signature appearance can dynamically change to reflect validation or invalidation of the electronic signature.

Accordingly, since the references combined do not teach or suggest all limitations of claim 17, a *prima facie* case of obviousness has not been established. Claims 18-32 depend from claim 17 and are therefore allowable for at least the same reasons.

Claims 1-16

Claim 1, a method claim, similarly requires previewing an electronic signature appearance in a bounding region and the ability to then edit the electronic signature appearance after previewing but before electronically signing the document. The electronic signature appearance includes multiple layers that can dynamically change to reflect validation or invalidation of the electronic signature. Accordingly, claim 1 is also not obviousness in view of Outlook combined with the AAPA. Claims 2-16 depend from claim 1 and are therefore also in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

The rejections of record are clearly improper and without basis and should be withdrawn. Moreover, it is respectfully submitted that all of the claims are in condition for allowance, and a notice of allowance is respectfully requested.

This amendment is being filed with a Request for Continued Examination. The RCE fee in the amount of $810 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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